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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,784	08/17/2007	Paivi Maatta	0696-0244PUS1	1424
2292 7590 04/06/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
GOFF II, JOEIN L				
ART UNIT		PAPER NUMBER		
1746				
NOTIFICATION DATE		DELIVERY MODE		
04/06/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

## Application No.

10/585,784

## Applicant(s)

MAATTA ET AL.

## Examiner

JOHN L. GOFF II

## Art Unit

1746

**Period for Reply**  
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,8(6) is/are rejected.
- 7) ☒ Claim(s) 7,8(7) is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the amendment filed on 2/15/11.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### **Specification**

3. The abstract of the disclosure is objected to because the specification does not provide any antecedent basis for the "laser head" claimed. The examiner agrees with applicants argument that the terminology laser head is a more accurate description of the "laser beam (10)" of the specification. It is suggested to delete each occurrence of "laser beam (10)" from the specification and insert therein - - laser head (10) - - to overcome the objection. Correction is required. See MPEP § 608.01(b).

### **Claim Rejections - 35 USC § 103**

4. Claims 6 and 8(6) are rejected under 35 U.S.C. 103(a) as being unpatentable over Bachhofer et al. (U.S. Patent 6,060,681) in view of Fukahori (JP 06-182571 and see also the abstract and machine translation).

Bachhofer discloses an apparatus comprising a clamp (9) having jaws (10) capable of retaining two sealable paper or board members in position located with respect to each other and a sealing line and a laser sealing means capable of moving along the sealing line comprising a means (13 or 14) capable of pressing the members apart and opening a seal point and a laser

head (5, 6) for directing a laser beam (7) capable of melting a plastic coating at the opened seal point. The laser sealing means is capable of performing a reciprocating movement (Column 3, lines 17-21). Bachhofer is silent as to a seal closing means. However, it was known in a substantially similar apparatus that following the laser sealing means a seal closing means (17) is included for the capability of pressing the members against each other and concealing the weld as shown by Fukahori (See the abstract and Figure 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the apparatus taught by Bachhofer a seal closing means as suggested by Fukahori to provide the capability of pressing the members against each other to conceal the weld.

It is noted "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." and "A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim." (MPEP 2114 and 2115). The apparatus taught by Bachhofer as modified by Fukahori includes all of the structure claimed as set forth above and is capable of performing the intended use recited on the material worked upon recited, i.e. the structure is capable of sealing members made of plastic-coated paper or board by a method comprising jointing of the members along a sealing line by melting the plastic coating of at least one member with a laser beam, the plastic coating adhering the members to each other when solidified, wherein the members to be sealed are gripped adjacent the sealing line in order to retain the members in position during the sealing and performing sealing by means of a sealing means which moves along the sealing line and presses the

members apart in order to keep a seal point open, directs a laser beam to the open seal point for melting the plastic, and finally presses the members against each other for closing the seal, the laser sealing means performing a reciprocating movement

It is noted “means for opening the seal point” is considered to invoke 35 USC 112 sixth paragraph wherein the means (13 or 14) taught by Bachhofer for opening the seal point is considered an equivalent of the means-plus-function claimed as the means performs the function specified in the claim and is not excluded by any explicit definition provided in applicants specification.

#### **Allowable Subject Matter**

5. Claims 7 and 8(7) would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

The claims are allowable for the same reasons given in paragraph 13 of the office action mailed 11/16/10.

#### **Response to Arguments**

7. Applicant's arguments filed 2/15/11 have been fully considered but they are not persuasive.

Applicants argue, “The statement of the rejection characterizes the Bachhofer apparatus as being “capable of retaining two sealable paper or board members.” Bachhofer, however, by its

own terms teaches an apparatus “for laser welding two metal sheets.” The Examiner is respectfully requested to explain how it was determined that “Bachhofer discloses an apparatus ... capable of retaining two sealable paper or board members” as contended in the paragraph bridging pages 4-5 of the Office Action.”.

Claim 7 is an apparatus claim. As noted in the rejection, “A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim.” (MPEP 2114). The apparatus taught by Bachhofer as modified by Fukahori teaches all of the structural limitation of the claim including a clamp, i.e. two pressure rollers 10. The clamp is capable of retaining two sealable paper or board members in the same manner in which it is capable of retaining two metal sheets.

Applicants further argue, “The manufacture of paper and board articles – as in the present invention – and manufacture in the metal industry are technologically remote fields with respect to one another; A person of ordinary skill in the paper/board making arts would not seek solutions from the metal welding arts. For this reason alone, the rejection of record is untenable.”.

Claim 7 is an apparatus claim. “Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.” (MPEP 2115). There is no requirement that the references of the rejection expressly teach paper and board articles.

Applicants further argue, “Also, neither Bachhofer nor Fukahori discloses the claimed combination of (i) means for pressing members apart to open a line for sealing, ii) a laser head

emitting a laser beam to melt a plastic coating, and (iii) means for pressing back the members to close the sealing, all of these parts together forming an integral unit (“a sealing means 7”) moving along the sealing line and thus effecting an entire sealing operation.”.

None of the claims define the means for pressing members apart, a laser head, and means for pressing back the members as an integral unit rather the apparatus claimed comprises these parts. Bachhofer as modified by Fukahori teach an apparatus for sealing including a means for pressing members apart, a laser head, and means for pressing back the members which entire apparatus moves along the sealing line as taught by Bachhofer (Column 3, lines 17-21).

### **Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JOHN L. GOFF** whose telephone number is **(571)272-1216**.

The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katarzyna Wyrozebski can be reached on (571) 272-1127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John L. Goff/  
Primary Examiner, Art Unit 1746